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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional)	
		915-001.043	
<p>I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]</p> <p>on <u>August 9, 2007</u></p> <p>Signature <u>Kathleen Sipos</u></p> <p>Typed or printed name <u>Kathleen Sipos</u></p>		<p>Application Number</p> <p><u>10/516,641</u></p>	<p>Filed</p> <p><u>May 26, 2005</u></p>
		<p>First Named Inventor</p> <p><u>Seppo HAMALAINEN</u></p>	
		<p>Art Unit</p> <p><u>2617</u></p>	<p>Examiner</p> <p><u>Bryan J. FOX</u></p>
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input type="checkbox"/> attorney or agent of record. Registration number _____</p> <p><input checked="" type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 <u>58,051</u></p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p> <p><input type="checkbox"/> *Total of _____ forms are submitted.</p>			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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PATENT  
Attorney Docket No. 915-001.043

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Re Application of:

**Seppo HAMALAINEN** : Confirmation No.: **6961**  
Serial No.: **10/516,641** : Examiner: **Bryan J. FOX**  
Filed: **May 26, 2005** : Group Art Unit: **2617**

For: **CONTROL OF INTERFREQUENCY HANDOVERS**

Mail Stop AF  
Commissioner For Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

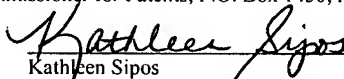
Sir:

In response to the final Office Action of May 9, 2007, please reconsider the rejections in light of the following remarks:

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CERTIFICATE OF MAILING

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Kathleen Sipos  
Dated: August 9, 2007

REMARKS

Claims 1-27 were examined by the Office, and in the final Office Action of May 9, 2007 all claims are rejected. Applicant respectfully submits that the Office has committed clear error in rejecting the claims, because the Office has failed to show that there is proper motivation to combine the cited references, and in turn that the cited references, alone or in combination, disclose or suggest all of the limitations recited in the claims. Applicant respectfully requests reconsideration and withdrawal of the rejections in light of the following discussion.

This Pre-Appeal Brief Request for Review is submitted along with a Notice of Appeal.

Claim Rejections Under § 103

On page 2 of the Office Action, claims 1-2, 5-6, 8-13, 24-25 and 27 are rejected under 35 U.S.C. § 103(a) as unpatentable over Hamalainen et al. (WO 01/31958) in view of Park et al. (U.S. Patent No. 6,385,437). Applicant respectfully submits that claim 1 is not disclosed or suggested by the cited references, alone or in combination, because there is no motivation to combine the cited references to arrive at the limitations recited in claim 1.

Claim 1 recites changing the operation of a mobile station into a combined slotted communication mode and measurement mode for preparing for an interfrequency handover, if a criterion specifying that a quality of a downlink signal is worse than a quality represented by a first target value is fulfilled. In claim 1, the first target value depends on a second target value, and the second target value is related to an outer loop power control of a transmission power of the downlink signal. Therefore, when the quality of the downlink signal is worse than the quality represented by the first target value the criterion is fulfilled, and the mobile station prepares for an interfrequency handover. The present application, as recited in claim 1, uses the first target value that depends on the second target value related to outer loop power control as part of the determination as to when to prepare for an interfrequency handover. In contrast to claim 1, none of the cited references, disclose or suggest using a first target value depending on a second target value in making a determination as to when to prepare for an interfrequency handover.

Furthermore, even if the elements recited in claim 1 were separately known in the art, which applicant does not admit, the Office must show some motivation or suggestion to combine the teachings to arrive at the limitations recited in claim 1. While the Office asserts on page 18 of the Office Action that the idea of a first threshold being dependent upon a second threshold related to outer loop power control is known, citing Blanc (U.S. Patent No. 6,341,225), the Office offers no

motivation or suggestion as to why one of skill in the art would be motivated to use the first threshold as part of a criteria related to when a mobile station should prepare for an interfrequency handover, as recited in claim 1.

Hamalainen is directed to a method in which as a response to fulfilment of at least one criteria during continuous communication mode, the operation of a mobile station is changed into the combined slotted communication mode and measurement mode. See Hamalainen Abstract. In contrast to claim 1, the criteria discussed in Hamalainen are (1) the serving base station repeatedly asks for more uplink power, (2) the level of wideband interference appears to be higher than it should be, (3a) the non-orthogonal narrowband neighboring channel interference obtained from measurements on own channel is high, and (3b) the total non-orthogonal narrowband interference is remarkably higher than an estimated co-channel non-orthogonal interference. For criteria 3b, Hamalainen discusses that it is advantageous to set a threshold value at least by which the total narrowband interference must be higher than the estimate before the criteria is considered fulfilled, because the estimate is not an exact value. See Hamalainen page 11, lines 5-9. In contrast, the criteria recited in claim 1 is that the quality of a downlink signal is worse than a quality represented by the first target value. The first target value depends on the second target value, and is not merely an estimate of co-channel interference as discussed in Hamalainen. Therefore, based on the teachings of Hamalainen, one of skill in the art would not be motivated to use the criteria recited in claim 1, because Hamalainen completely fails to disclose or suggest anything related to outer loop power control as acknowledged by the Office on page 3 of the Office Action.

Furthermore, one of skill in the art would not be motivated to combine the teachings of Park with those of Hamalainen to arrive at the limitations recited in claim 1. Park is directed to a power control method for a mobile station which has at least one compressed mode frame. As set forth in the Abstract of Park, a compressed mode frame includes a data transmission duration where data is transmitted at a first frequency and a data transmission-off duration where a second frequency is searched to perform an inter-frequency handoff to the second frequency. The transmission power during the data transmission duration is increased to compensate for the loss of transmission power during the data transmission-off duration, and the method disclosed in Park is for the base station to set a power control threshold depending on the length of the data transmission-off duration. Thus, the base station receives transmission power-increased data from the mobile station and compares the received signal power of the data signal with the power control threshold. The base station generates a power-up

command when the power control threshold is higher than the receiving power and generates a power-down command when the power control threshold is lower than the received signal power.

Thus, Park discloses a method in which the outer loop power control target is increased by an incremental amount ( $\Delta_{\text{target}}$ ) in a frame where compressed mode is used and inter-frequency handovers are made. In contrast, in claim 1 SIR is compared to an outer loop target (first target value that depends on a second target value related to outer loop power control of a transmission power of the downlink signal) and used as a trigger for interfrequency handover and therefore compressed mode.

There is no suggestion at all in Park or Hämäläinen of changing the operation of the mobile station from continuous communication mode to combined slotted communication mode and measurement mode depending upon a target being exceeded, where that target itself is related to outer loop power control of a transmission power of the downlink signal to the mobile station. Instead, the Office has committed clear error by engaging in impermissible hindsight reasoning to arrive at the limitations recited in claim 1. When making an obviousness determination the invention cannot be evaluated part by part. *Ruiz v. A.B. Chance Co.*, 69 USPQ2d 1686, 1690 (Fed. Cir. 2004). Otherwise an obviousness assessment breaks an invention into its component parts (A+B+C), and finds a prior art reference containing A, another containing B, and another containing C, and on that basis alone declare the invention obvious. *Id.* Using the invention as a roadmap in order to find its components in the prior art is impermissible hindsight reasoning. *Id.*; see also *In re Gorman*, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991) (it is impermissible simply to engage in hindsight reconstruction of the claimed invention using the applicant's structure as a template and selecting elements from references to fill the gaps). When an invention is contended to be obvious based on a combination of elements across different references, there must be a suggestion, motivation or teaching to those skilled in the art for such a combination. *Barbell Co. v. USA Sports Inc.*, 73 USPQ2d 1225, 1227 (Fed. Cir. 2004) (emphasis added). The Office has engaged in impermissible hindsight reasoning by using the invention recited in claim 1 as a roadmap, and finding its component parts from the teachings of the cited references. The Office's reliance upon Blanc on page 18 of the Office Action evidences that the Office has merely found the component parts of claim 1, without providing proper motivation or suggestion to combine the teachings to arrive at the claimed limitations. However, there is no motivation or suggestion to combine the cited references to create a criteria based on the quality of the downlink signal in relation to the quality represented by a first target value, as recited in claim 1. Therefore, for all of the foregoing reasons, it is respectfully submitted that claim 1 is not disclosed or suggested by the cited references, alone or in combination.

Since claim 1 is believed to be not suggested by Hämäläinen in view of Park, it is respectfully submitted that claims 2, 5, 6 and 8-13 are also not suggested by Hämäläinen in view of Park since all of these claims ultimately depend from claim 1.

Similarly, independent method claim 24, independent mobile station claim 25, and independent mobile station claim 27 recite limitations similar to claim 1 and, for similar reasons, are believed to be not suggested by Hämäläinen in combination with Park.

Furthermore, claims 3, 4 and 7 are believed to be not suggested by Hämäläinen in view of Park further in view of Tiedmann, Jr. et al (U.S. Publ Appl. No. 2002/0126739), since each of these claims ultimately depend from claim 1 which is believed to be allowable.

Similarly, dependent claims 14-22 which ultimately depend from claim 1 and claim 26 which depends from claim 25 are believed to be not suggested by Hämäläinen in view of Park, further in view of Wakizaka (U.S. Patent No. 6,081,714), due to the fact that each of these claims depend from an independent claim which is believed to be distinguished over the cited art.

Finally, claim 23 which is rejected as obvious in view of Hämäläinen, further in view of Park, further in view of Subrahmanya (U.S. Patent No. 6,807,429), is believed to be allowable in view of its dependency from claim 1.

#### Conclusion

The rejections of the Office Action having been shown to be inapplicable, withdrawal thereof is requested, and passage to issue of the present application is earnestly solicited. The undersigned hereby authorizes the Commissioner to charge deposit account 23-0442 for any fee deficiency required to submit this response.

Respectfully submitted,

Date: 9 August 2007

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